UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/838,330	04/20/2001	Michael B. Marks	BOX-2	1032

7590 06/29/2004

Brad I. Golstein
Metro88
20755 Plummer Street
Chatsworth, CA 91311

EXAMINER	
HASHEM, LISA	

ART UNIT	PAPER NUMBER
2645	8

DATE MAILED: 06/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/838,330	MARKS ET AL.	
	Examiner	Art Unit	
	Lisa Hashem	2645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 April 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☐ Claim(s) _____ is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *03 August 2001* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

FINAL DETAILED ACTION

Drawings

1. The correction to the drawings was not received in the Amendment filed on April 15, 2004. The replacement sheet following page 15 of the Amendment was not attached.

2. In order to avoid abandonment, the drawing informalities noted in the paper mailed on December 19, 2003, must now be corrected. Correction can only be effected in the manner set forth in the above noted paper.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 1 recites the limitations "the time availability" and "the moment" in lines 17-18 on page 30. There is insufficient antecedent basis for these limitations in the claim.

5. Claim 9 recites the limitations "the moment" and "the listener" in lines 32-33 on page 31 and line 4 on page 32, respectively. There is insufficient antecedent basis for these limitations in the claim.

6. Claim 17 recites the limitation "the course" in line 30 on page 33. There is insufficient antecedent basis for this limitation in this claim.

Inventorship

7. Receipt is acknowledged of the statement requesting that Derrell Lipman be deleted as a named inventor, which was filed with the Continued Prosecution Application (CPA) on April 15, 2004. The inventorship has been corrected as requested.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claim 1-20 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by U.S. Patent No. 6,587,127 by Leeke et al, hereinafter Leeke.

Regarding claim 1, Leeke discloses a method for creation of a personalized playlist of programming, the playlist comprising sequentially played identifiable items of content from available sources of program material wherein (see Abstract; column 5, lines 1-6; column 8, lines 3-16): a user selects a base/top channel or first preset that includes a playlist of content that may be played on a user device, the playlist of the base channel being immediately unchangeable and identical for a plurality of users; alternate sources of content offer items that are continuously available for use as substitutions for items of the playlist of the base channel as the base channel plays, at least one substitute item being used in the personalized playlist; the user reacts to items of the playlist of the base channel, whereby a side channel or second preset distinct from the base channel is created that reflects a user preference, the user preference defined at least in part by a user's reactions to items that have played on either of the base channel or the side channel, the side channel including the personalized playlist and being assembled substantially from items of the base channel and the alternate sources (see Figure 2; column 9, line 61 –column 10, line 14); a customizer or content delivery component operates with the user device to determine in near

real time which substitute items are included in the personalized playlist, the customizer using at least two criteria to define a sequence of items to play in the personalized playlist, a first criteria comprising the user preference, and a second criteria comprising a time availability of items provided by the alternate sources near a moment the customizer determines that a substitute item should be included in the sequence of items played (column 4, line 50 – column 5, line 5; column 8, lines 17-20; column 9, lines 17-26; column 16, lines 25-34); a first suitable item from a first alternate source being buffered in a memory facility linked to the user device before the first suitable item is needed for use in the side channel, the first suitable item inherently being unidentified to the user unless it is played on the user device (column 4, lines 21-49; column 8, line 66 – column 9, line 7; column 10, lines 5-20; column 28, lines 4-6); the base channel and the alternate source of content are streaming broadcast sources that are available to a plurality of users of a data system (column 4, lines 8-12; column 8, lines 3-16); an undesired item is streamed by a provider of programming on either of the base channel or the side channel, the undesired item is inherently identified by the customizer as not meeting the first criteria, and the first suitable item plays on the side channel from a beginning of the first suitable item as a substitute for the undesired item (column 10, lines 50-56; column 17, lines 4-14); the user device is configured whereby the listener may immediately select either one of the base channel and the side channel (column 10, lines 33-49).

Regarding claim 2, the playlist creation method of claim 1, wherein Leeke further discloses a second suitable item is streamed from a second alternate source at a beginning later than a beginning of the first suitable item streamed by the first alternate source, and the second suitable item begins at the second alternate source before it is needed for play on the side

channel, the second suitable item inherently being a better fit to the first criteria than the first suitable item, the first suitable item being removed from the memory facility in favor of the second suitable item (column 10, lines 5-14; column 10, lines 50-56; column 14, lines 6-13; column 31, line 57 – column 32, line 34).

Regarding claim 3, the playlist creation method of claim 1, wherein Leeke further discloses the substitute items inherently have two distinct types of value, a value of creative content and an opportunity value of time availability for use as a substitute item in the side channel (column 9, lines 17-26; column 14, lines 6-13; column 28, lines 7-8).

Regarding claim 4, the playlist creation method of claim 3, wherein Leeke further discloses a provider of the alternate source receives an opportunity value payment or reward from a provider of the base channel when an item from the alternate source is substituted into the personalized playlist; wherein a user may give a positive rating for a track of an album by a particular jazz artist, the positive rating can be viewed by other users to see and an album comprising the track can be purchased by user (column 10, lines 5-14; column 35, lines 42 – column 36, line 5; column 38, lines 54-60).

Regarding claim 5, the playlist creation method of claim 1, wherein Leeke further discloses an alternate source comprises a hidden channel, the hidden channel is not available for use as a base channel, and the hidden channel serves a primary function to provide items of content as components for use in assembling personalized playlists (column 8, lines 6-11).

Regarding claim 6, the playlist creation method of claim 1, wherein Leeke further discloses the programming is audio programming, the undesired items of content are inherently audio commercial announcements, and substitute items are inherently used to replace the audio

commercials (column 47, line 61 – column 48, lines 25-33; column 49, lines 21-30).

Regarding claim 7, the playlist creation method of claim 1, wherein Leeke further discloses a provider of the base channel is identified on a display screen of the user device (see Figure 2; column 7, lines 38-54).

Regarding claim 8, the playlist creation method of claim 1, wherein Leeke further discloses the user preference comprises a set of instructions that is stored on a device of the user, the instructions being used to guide the customizer in a selection of items for the user (column 4, lines 56-61; column 23, lines 41-59).

Regarding claims 9-11 and 13, please see the rejections of the method in claims 1, 5, 3, and 8, respectively, to reject the method in claims 9-11 and 13.

Regarding claim 12, the playlist creation method of claim 11, wherein Leeke further discloses a creator of an item of content receives a royalty payment or reward when the item is used in a playlist of the side channel; wherein the user can rate the item of content and a positive rating can be viewed by other users and an album comprising the item of content can be purchased by users (column 35, lines 42 – column 36, line 5; column 38, lines 54-60), and a provider of the alternate source receives an opportunity value payment or reward when an item from the alternate source is substituted into the personalized playlist (column 24, lines 12-16).

Regarding claim 14, please see the rejections of the method in claims 1 and 5 to reject the method in claim 14.

Regarding claim 15, please see the rejection of the method in claim 11, wherein Leeke further discloses provider of the hidden channel receives an opportunity value payment when the item from the hidden channel is used in the personalized playlist (column 24, lines 12-16).

Regarding claim 16, please see the rejection of the method in claims 14 and 15 to reject the method in claim 16.

Regarding claim 17, the playlist creation method of claim 16, wherein Leeke further discloses the station operates as an affiliate of a cooperative network with other stations, and the affiliate stations share resources in the course of assembling playlists for listeners of affiliate stations (column 8, lines 3-16).

Regarding claim 18, please see the rejection of the method in claim 14 to reject the method in claim 18.

Regarding claim 19, please see the rejection of the method in claim 7 to reject the method in claim 19.

Regarding claim 20, please see the rejection to the method in claims 16 and 17, wherein Leeke further discloses the standardized method includes a multipurpose addressing system using telephone numbers, a telephone number serving at least two functions: a first function being to access a remote voice telephone device or pager, and a second function being to access the programming of the program provider, the program provider thereby being identified by a multipurpose telephone number; the user being able to use a device to select which of the two functions are served by the telephone number (column 16, lines 43-62).

Response to Arguments

10. Examiner acknowledges the cancellation of claims 21-22 cited in the Amendment received on April 15, 2004.

11. Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure

- U.S. Patent No. 6,192,340 by Abecassis discloses an apparatus capable of playing audio comprising communicating a user's information preferences to an information provider; receiving, from the information provider, informational items that are responsive to the user's information references; wherein a verified apparent listening of a playing of an informational item is associated with a credit

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

14. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Or faxed to:

(703) 872-9314 (for formal communications intended for entry)

Or call:

(703) 306-0377 (for customer service assistance)

Hand-delivered responses should be brought to: Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lisa Hashem whose telephone number is (703) 305-4302. The examiner can normally be reached on M-F 8:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (703) 305-4895. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

LH

lh
June 17, 2004

FAN TSANG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600